

REMARKS

The following Remarks supplement the Remarks set forth in applicant's Amendments filed May 12, 2006, and June 19, 2006, responsive to the non-final Office Action dated November 14, 2005.

As earlier pointed out, the claims set forth in this Supplemental Amendment are identical to the claims as presented in the Amendment filed May 12, 2006 except for claims 1, 8 and 15 which have been amended herein to call for the cylindrical distal end of the leverage end cap as having an external diameter substantially the same as the diameter of the baton handle.

It is again pointed out that the word "service" appearing in line 6 of the first full paragraph on page 9 of the Amendment filed May 12, 2006 should read --surface--. It is also pointed out that the word --not-- should appear before the word "meet" in line 17 of the third-from-last paragraph in applicant's Supplemental Amendment filed Jun 19, 2006, so that the related sentence reads: "Moreover, the upper member 8 of the Ashihara crosshandle...does not meet many of the structural features called for in applicant's claims"

Applicant's claim 1, and thus also dependent claims 2-7, has been amended to call for the unitary body of the leverage end cap as having an integral longitudinally extending generally cylindrical end opposite the enlarged knob end, the cylindrical end having an external diameter substantially the same as the cylindrical handle portion of the baton for attaching the end cap to the baton in substantially axial alignment therewith. The unitary body is further defined as having a reduced diameter circumferential groove of generally U-shaped concave profile intermediate and contiguous to both the knob and attaching ends and configured and sized to receive the little finger of the user's hand adjacent the little finger during use with at least the pointing finger of the user's hand wrapping about and gripping the handle portion of the baton, wherein during use the end cap creates a fulcrum point at the user's little finger increasing the effective moment arm of the baton and preventing release of the baton from the user's grip.

Applicant's amended independent claim 8 is generally similar to amended claim 1 in calling for the body of the leverage end cap as having a groove of generally U-shaped concave profile and disposed between and contiguous to the knob and cylindrical distal end of the body with the groove having a minor transverse cross-sectional area substantially less than the cross-sectional area of the distal end of the body to receive the little finger of a user's hand in wrapped relation about the groove so that the little finger is captured between the knob and cylindrical

distal end. Claim 8 also calls for the end cap as having a longitudinal length so that at least the pointing finger of the user's gripping hand can grip a proximal end of the baton handle with the leverage end cap creating an increased moment arm fulcrum at the annular groove.

Applicant's independent claim 18 and dependent claim 19 also call for a leverage end cap that has an enlarged knob end and defining a circumferential reduced diameter curvilinear surface between and contiguous to the enlarged knob and sized to establish a finger grip to receive only the little finger of a user's hand in wrapped relation on the end cap when the proximal end of the baton handle is grasped in the user's hand to thus create a greater effective impact force moment for the baton than when the tubular handle of the baton is grasped generally midlength.

Applicant's claims 15, 16, 20 and 21 call for a method of increasing the average impact force obtainable with a baton wherein the structural features of the baton and leverage end cap enable a greater effective impact force to be achieved during grasping and use of the baton.

The Declaration Under 37 C.F.R. §1.132 of applicant Kevin L. Parsons, PhD, filed with the Supplemental Amendment filed June 19, 2006, is incorporated by reference. Paragraph Nos. 7 and 8 of Dr. Parsons' Declaration set forth the background of his invention as explained during the March 24, 2006 telephone interview with Examiner Jackson. As stated, Dr. Parsons and his company ASP have received over 100 U.S. patents on various law enforcement equipment including expandable batons which ASP has manufactured and sold since the early 1990s. Paragraph No. 8 of Dr. Parsons' Declaration describes how the increasing need for law enforcement personnel lead to more individuals getting involved in law enforcement that did not have the upper body strength as traditional relatively large male dominated police officers. This trend led to requests from law enforcement personnel for smaller and lighter equipment so that smaller police officers, many of whom are female and not as large as the traditional male police officers, could readily manipulate their equipment and effectively carry out their law enforcement duties without endangerment to themselves in crisis situations. In effect, what was requested was a means to increase the striking force potential of batons that were made shorter in length and thereby lacked the striking force capable with longer heavier batons. This lead to ASP, and particularly Dr. Parsons, developing the leverage end cap as defined, for example, in the aforescribed amended claim 1, and which enables the user to place his/her little finger of the gripping hand in the generally U-shaped profile annular groove in the leverage end cap and

thereby create a fulcrum point at the user's little finger to increase the effective moment arm of the baton and thereby increase the striking force potential of a smaller lighter weight baton. The aforescribed need for improving the striking force potential of a shorter (and thereby lighter) baton became apparent as the makeup of law enforcement personnel changed from traditional large size men to include smaller size law enforcement personnel and can be considered as a long felt but unsolved need.

Paragraph No. 9 of Dr. Parsons' Declaration, demonstrates significant commercial success with the leverage end cap as defined in the claims of the subject application as aforescribed. In this respect, Dr. Parsons states that ASP has sold over two million (2,000,000) leverage end caps for use with batons and as defined in the pending claims.

The aforementioned factors of solving a long felt need with the leverage end cap as defined in applicant's claims, and the commercial success evidenced by the sale of over two million leverage end caps as defined in the pending claims, constitute secondary indicia of non-obviousness as stated by the Supreme Court in *Graham v. John Deere Co.*, 383 U.S. 1 (1966) and followed in a multitude of patent opinions rendered by the United States Court of Appeals for the Federal Circuit.

Paragraphs Nos. 10-13 of Dr. Parsons' Declaration address the Examiner's rejection of the claims pending in the application as of the November 14, 2005 Office Action but also states that his comments apply equally to the claims as presented in the Amendment filed May 12, 2006 in the subject application.

The basis for the Examiner's rejection of the claims pending in the application as of the November 14, 2005 Office Action is set forth in both the Amendment filed May 12, 2006 and in Dr. Parsons' Declaration. As reiterated in the recent Federal Circuit decision in *In re Kahn*, Fed. Cir. docket 04-16-16, decided March 22, 2006, most inventions arise from a combination of old elements and each element may often be found in the prior art, citing *In re Rouffet*, 149 Fed. 3d 1350, 1357 (Fed. Cir. 1998). The opinion in *Kahn* further states: "However, mere identification in the prior art of each element is insufficient to defeat the patentability of the combined subject matter as a whole."

In the subject application, it is respectfully submitted that neither the Hustad nor Ashihara references teach or suggest the elements called for in applicant's claims now pending in the application. As set forth in applicant's Amendment filed May 12, 2006, the Examiner has

acknowledged on page 3 of the November 14, 2005 Office Action that Hustad does not specifically disclose that the tapered neck portion (what the Examiner has held to be represented by reference numeral 16 in the Hustad reference) is a circumferential groove of concave profile nor does the cylindrical segment distal end have a smaller external diameter than the knob of the end piece as claimed." The Examiner has held that Ashihara teaches an end cap for use with a leverage baton handle 2 and states: "Therefore, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to modify the end piece device of Hustad to incorporate the specific shape of the end cap as taught by Ashihara to provide an improved ergonomic end piece being sized to receive a user's finger in wrapped relation about a neck portion so that the finger is captured between a knob and a distal end such that a baton can be held firmly adjacent a proximal end of the baton with at (sic – a) steadfast and leveraged grip."

As pointed out in paragraph No. 6 in the Parsons' Declaration, the claims in the subject application (both article claims 1-14, 18, 19 and 22, and method claims 15, 16 and 20) call for the reduced diameter circumferential groove in the unitary body of the claimed leverage end cap as being sized to receive the little finger of the user's hand. This determines the proper gripping orientation of the hand on the leverage end cap during use with the remaining fingers and thumb gripping the distal end of the end cap and at least the pointing finger of the hand gripping the handle portion of the baton. The claimed manner in which the leverage end cap is gripped is important to achieving the object of the leverage end cap in association with the baton; namely, increasing the fulcrum length of the baton and thereby its striking force over conventional hand-gripping of only the cylindrical handle portion of a baton.

Finally, as stated in the Supplemental Amendment filed June 19, 2006, the Examiner has set forth no motivation found in either the Hustad or Ashihara references for modifying the Hustad pressure point device in a manner to achieve applicant's claimed invention. As the court said in *In re Kahn*, the "motivation-suggestion-teaching" test asks not merely what the references disclose, but whether a person of ordinary skill in the art, possessed with the understandings and knowledge reflected in the prior art and motivated by the general problem facing the inventor, would have been lead to make the combination recited in the claims, citing *Cross Med. Products*, 424 Fed. 3d at 1321-24. As pointed out in both applicant's Amendment filed May 12, 2006 and in the Parsons' Declaration, gripping the Hustad pressure point device as suggested by the

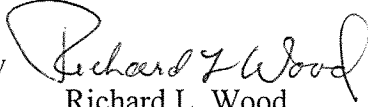
Examiner would not only be uncomfortable, but would tend to expand the user's hand while at the same time the user is trying to contract the little finger around the reduced diameter intermediate shaft 16. This would make it difficult at best to use the little finger position as the fulcrum point for increasing the leverage force applied by the baton when striking an object, thereby significantly inhibiting one from readily achieving the result called for in applicant's pending claims. It is also respectfully pointed out again that the Ashihara reference specifically states that the outer circumferential surface 8c "is gripped with a thumb and forefinger being positioned there around." (Col. 7, lines 32-34.) Moreover, the upper member 8 on the Ashihara crosshandle is rotatable and does not meet many of the structural features called for in applicant's amended claims. Again, the Examiner has provided no basis for how the Hustad and Ashihara references would motivate one to modify the pressure point device of Hustad to achieve the claimed leverage end cap or method of increasing the leverage impact force obtainable with a baton as called for in applicant's pending claims. As stated in *In re Rouffet, supra*, at 1357: "To prevent the use of hindsight based on the [applicant's] invention to defeat patentability of the invention, this court [the Federal Circuit] requires the examiner to show a motivation to combine the references that create the case of obviousness."

Accordingly, in view of the foregoing, allowance of claims 1-10, 12-16 and 18-22 as now presented is believed to be in order and such action is earnestly solicited.

Should the Examiner determine that a telephone discussion with applicant's undersigned attorney would expedite prosecution of the application, it is respectfully requested that he initiate such a discussion.

Respectfully submitted,

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